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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,181	12/31/2003	Kenichi K. Yabusaki	03-YAB-117	3401

23843 7590 08/29/2005
FOOTHILL LAW GROUP, LLP
3333 BOWERS AVE., SUITE 130
SANTA CLARA, CA 95054

EXAMINER

PARSLEY, DAVID J

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,181

Applicant(s)

YABUSAKI, KENICHI K.

Examiner

David J. Parsley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Amendment

1. This office action is in response to applicant's amendment dated 6-22-05 and this action is final.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4, 7, 22-23, 26 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 1,997,339 to Olson.

Referring to claims 1 and 26, Olson discloses an instrument including an elongate body – at 10, having two straight parallel longitudinal sides, the sides – at the edges of item 10 in figures 3-5, comprise straight parallel longitudinal edges of the body – see at the sides of 10 in figures 3-5, the body forming a curved groove – at 11 in figure 3, or – where items 9 and 10 join in figure 5, between the longitudinal sides – see for example figures 3 and 5, an end section – at 9, the end section extending from the elongate body and tapering to a rounded point – see for example figures 3-5, and a plurality of tines – at 24,27 in figure 3 and – at 26,27 in figure 5, emanating

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form a surface of the instrument, wherein at least one tine of the plurality of tines – at 24 in figure 3 and – at 26 or 27 in figure 5, emanates from the end section and is directed away from the rounded point and towards the elongate body – see for example figures 3 and 5, wherein at least one tine of the plurality of tines – see at 27 in figure 3 and – at 26 and 27 in figure 5, emanates from a location away from the sides and away from the end section – see for example figure 3 and 5. Olson does not disclose the instrument is adapted to fit into the body of the bait fish and form a cavity when the instrument is inserted into the body rotated and removed. However, these limitations are intended use/functional limitations in an apparatus claim and therefore it is deemed that the device of Olson is capable of performing this function in that as seen in figures 3-5, the device is of a size that it can be placed into the body of a fish and then moved/rotated in the body of the fish.

Referring to claims 2 and 29, Olson discloses the instrument is made of steel – see page 2 column 1 lines 60-69.

Referring to claim 4, Olson discloses the at least one tine that emanates from the end section includes a plurality of tines – see at 24 and 27 in figure 3 and – at 26 and 27 in figure 5.

Referring to claim 7, Olson discloses the instrument is one integral piece – see for example figure 5.

Referring to claim 22, Olson discloses the groove comprises a substantially continuously curved groove – see at 11 in figure 3 and – at the connection of items 9 and 10 in figure 5.

Referring to claim 23, Olson discloses the sides – at the edges of item 10 in figures 3-5, comprise straight parallel longitudinal edges of the body and wherein none of the plurality of tines emanate from the edges – see for example figures 3-5.

Referring to claim 28, Olson discloses all of the tines of the plurality of tines emanate from the end section – see at 24 in figure 3 and – at 26 in figure 5.

Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,704,769 to Hanechak et al.

Referring to claims 16-18, Hanechak et al. discloses a plug-cut bait made of a fish with its head cut off – see for example figures 1-9.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olson as applied to claim 1 above, and further in view of U.S. Patent No. 2,533,445 to Finney.

Referring to claim 3, Olson does not disclose the instrument is made of stainless steel. Finney discloses the instrument is made of steel/stainless steel – see for example column 2 lines 8-14. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Olson and add the instrument made of stainless steel of Finney, so as to allow for the device to be rust-resistant and more durable.

Referring to claim 5, Olson does not disclose the plurality of tines emanate from the surface of the instrument at an angle in the range between about 15 degrees and about 45

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degrees. Finney does disclose the plurality of tines – at 6-8, from the surface of the instrument at an angle in the range between about 15 degrees and about 45 degrees – see for example figures 1-3. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Olson and add the tines emanating from the surface of the instrument at an angle of about 15 to 45 degrees of Finney, so as to allow for the device to facilitate cutting into an animal carcass.

Referring to claim 6, Olson does not disclose the end section includes a blade surface at the rounded point. Finney discloses the end section includes a blade surface – at 5, at the rounded point – see for example figures 1-2. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Olson and add the blade surface at the end section of Finney, so as to facilitate cutting into an animal carcass.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Olson as applied to claim 1 above. Olson does not disclose the body is the bait fish herring. However, it would have been obvious to one of ordinary skill in the art to take the device of Olson and add the body being the bait fish herring, so as to allow for the body to be prepared for further processing.

Claims 9-12, 14, 16, 19, 24-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finney in view of Olson and U.S. Patent No. 4,704,769 to Hanechak et al.

Referring to claims 9, 16 and 27, Finney discloses a method including, inserting an entrails removal instrument into a body, the instrument comprising, an elongate body – at 4-5, having two straight parallel sides, the sides comprise straight parallel longitudinal edges of the body comprise straight parallel longitudinal edges of the body – see figures 1-3, the body forming a curved groove between the longitudinal sides – see at the joining of items 4 and 6 in figure 4, an end section – at 5, the end section extending from the elongate body and tapering to

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a rounded point – see for example figures 1-2, and a plurality of tines – at 6-8, emanating from a surface of the instrument, wherein at least one tine – at 8, of the plurality of tines emanates from the end section and is directed away from the rounded point and towards the elongate body – see for example figures 1-3, wherein the entrails removal instrument is adapted to fit into the body and form a hollow cavity when the instrument is inserted into the body, rotated and removed – see for example column 2 lines 8-55 and column 3 lines 1-24. Finney does not disclose at least one tine of the plurality of tines emanates from a location away from the sides and away from the end section. Olson does disclose at least one tine – at 24 in figure 3 or – at 26,27 in figure 5, of the plurality of tines emanates from a location away from the sides and away from the end section – at the tip of item 9 – see for example figures 3-5. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Finney and add the at least one tine emanating from a location away from the sides of the instrument of Olson, so as to allow for the device to easily penetrate the fish. Finney further does not disclose cutting the head off a bait fish with a knife while leaving the body and tail intact, inserting the entrails removal instrument into the fish body to a position forward of the tail and removing the viscera of the fish leaving the body and tail intact with a cavity. Hanechak et al. does disclose cutting the head off a bait fish with a knife while leaving the body and tail intact – see for example figures 1-9, inserting the entrails removal instrument into the fish body – see figure 9, to a position forward of the tail – see figure 9, and removing the viscera of the fish leaving the body and tail intact with a cavity – see for example figures 1-9 and columns 3-4. Therefore it would have been obvious to one of ordinary skill in the art to take the method of Finney and add the cutting the head off the fish and

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then creating a cavity in the fish by removing the viscera of the fish of Hanechak et al., so as to allow for the fish to be prepared for eating or further processing.

Referring to claim 10, Finney as modified by Olson and Hanechak et al. further discloses the entrails remover is inserted at least 2 inches into the fish body – see for example figures 1-3, column 2 lines 8-55 and column 3 lines 1-15 of Finney and figure 9 of Hanechak et al.

Referring to claim 11, Finney as modified by Olson and Hanechak et al. further discloses moving the entrails removal instrument in a lateral motion – see for example column 2 lines 8-55 and column 3 lines 1-15 of Finney and columns 3-4 of Hanechak et al.

Referring to claim 12, Finney as modified by Olson and Hanechak et al. does not disclose the act of rotating includes rotating at least 360 degrees. However, it would have been obvious to one of ordinary skill in the art to take the device of Finney as modified by Olson and Hanechak et al. and add the act of rotating the instrument 360 degrees, so as to ensure that the entire viscera component can be contacted and removed by the device.

Referring to claim 14, Finney as modified by Olson and Hanechak et al. does not disclose the body is the bait fish herring. However, it would have been obvious to one of ordinary skill in the art to take the device of Finney as modified by Olson and Hanechak et al. and add the body being the bait fish herring, so as to allow for the body to be prepared for further processing.

Referring to claim 19, Finney as modified by Olson and Hanechak et al. does not disclose the bait fish is herring or anchovy or sardine or smelt. However, it would have been obvious to one of ordinary skill in the art to take the device of Finney as modified by Olson and Hanechak et al. and add the bait fish being herring or anchovy or sardine or smelt, so as to allow for the body to be easily processed for further processing.

Referring to claim 24, Finney as modified by Olson and Hanechak et al. further discloses the groove – see at item 4 of Finney and – at 11 of Olson, is a substantially continuously curved groove – see for example figure 1 of Finney and figure 3 of Olson.

Referring to claim 25, Finney as modified by Olson and Hanechak et al. further discloses the sides comprise straight parallel longitudinal edges of the body – see for example at the edges of 10 in figures 3-5 of Olson, and wherein none of the plurality of tines emanate from the edges – see for example figures 3-5 of Olson.

Claims 13, 15-18 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finney as modified by Olson and Hanechak et al. as applied to claim 12 above, and further in view of U.S. Patent No. 6,698,133 to Fricke.

Referring to claims 13 and 17, Finney as modified by Olson and Hanechak et al. does not disclose inserting at least one fishing hook attached to a fishing line into the hollow cavity and pushing it out through the fish body to form a bait. Fricke et al. does disclose inserting at least one fishing hook attached to a fishing line into the hollow cavity and pushing it out through the fish body to form a bait – see for example figures 10-11. Therefore it would have been obvious to one of ordinary skill in the art to take the device or Finney as modified by Hanechak et al. and add the inserting of the fishhook into the fish body of Fricke et al., so as to allow for the device to be used to catch fish.

Referring to claims 15 and 18, Finney as modified by Olson, Hanechak et al. and Fricke et al. further discloses a plurality of fishing hooks – see for example column 7 lines 41-51 of Fricke et al.

Referring to claims 20-21, Finney as modified by Olson, Hanechak et al. and Fricke et al. does not disclose the bait fish is herring or anchovy or sardine or smelt. However, it would have been obvious to one of ordinary skill in the art to take the device of Finney as modified by Olson, Hanechak et al. and Fricke et al. and add the bait fish being herring or anchovy or sardine or smelt, so as to allow for the body to be easily processed for further processing.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanechak et al. as applied to claims 16-18 above. Hanechak et al. does not disclose the bait fish is herring or anchovy or sardine or smelt. However, it would have been obvious to one of ordinary skill in the art to take the device of Hanechak et al. and add the bait fish being herring or anchovy or sardine or smelt, so as to allow for the body to be easily processed for further processing.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Olson as applied to claim 26 above, and further in view of Hanechak et al. Olson does not disclose the instrument comprises plastic. Hanechak et al. does disclose the instrument comprises plastic – see for example column 2 lines 66-68 and column 3 lines 1-3. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Olson and add the instrument made of Hanechak et al., so as to allow for the device lightweight and maintain durability.

Response to Arguments

4. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patent is cited to further show the state of the art with respect to hand held tools in general:

U.S. Pat. No. 6,786,472 to Dahl – shows tool with sides and tines

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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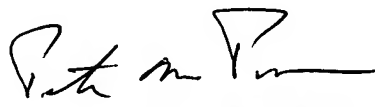
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Parsley whose telephone number is (571) 272-6890.

The examiner can normally be reached on Monday-Friday from 8am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DP
David Parsley
Patent Examiner
Art Unit 3643


PETER M. POON
SUPERVISORY PATENT EXAMINER
8/25/05